

pins.

16.(TWICE AMENDED) A composite scaffolding plank comprising a plurality of wooden boards held together in compression by a plurality of helical pins, each of said pins having a square cross section, each said wooden board having a fiber bending value of at least 2200 psi and a modulus of elasticity in the range of 1.6×10^6 to 1.8×10^6 .

A MARKUP AND A CLEAN COPY OF THE AMENDED CLAIMS ARE ATTACHED.

REMARKS

Claims 1-13 and 16 remain in the application.

The rejection of claims 1-13 under 35 USC 103(a) over Larsen is respectfully traversed.

In regard to claims 1-15 Larsen discloses planks held together by U clamps and notes that in the prior art it was known that planks arranged side by side could be penetrated and held together by a transverse metal rod at the ends. Larsen shows a scaffolding with two adjacent planks having a pin 5 extending there through the plank. According to translation, "the surface elements comprise multiple planks arranged side by side and penetrated and held together by a transverse connecting iron at each end of the element" (page 2, third paragraph). No information is provided on the process of attaching the elements together other than the pins 5 are driven through holes 7. The invention is the use of the U shaped clamp which drops over a rod 5 in each of two abutting elements and over a cross member 12. Driving the pin 5 through a hole 7 is not a suggestion or disclosure to place the pin in the boards under compression as recited in the present claims.

The Examiner has failed to make out a *prima facie* case of obviousness here,

additionally because he has used a legal conclusion as evidence. Inventions are obvious over references and the examiner has not cited any reference to support his legal conclusion of "to enhance the integrity" regarding the use of more pins than just the two used by Larsen, "conventional practice" regarding alternating wood grain and, "obvious mechanical expedient" regarding the plank dimensions and wood properties. (See *In re Bezombes*, 164 USPQ 387, 391 (CCPA 1970). This resort to a clichéd extension of the knowledge of one of ordinary skill in the art in the face of the total absence, even in non analogous art, to include the invention does not represent a proper basis for maintenance of the rejection of the present claims. Begging the issue by a term such as ""obvious mechanical expedient" does not apprise applicant of the basis of the rejection. It may be an "obvious mechanical expedient" or similar connotation but how can this make it less of an invention. (*In re Bezombes, et al., supra*). Most inventions are "obvious mechanical expedients" arranged in a non obvious manner.

The fact that Larsen is silent on these points cannot be used as evidence to draw any conclusion. Silence in a reference is not a proper substitute for an adequate disclosure of facts. *In re Burt*, 148 USPQ 548 (CCPA 1966). "Much confused thinking could be avoided by realizing that rejections are based on statutory provisions, not on references, and that the references merely supply the evidence of lack of novelty, obviousness, loss of right or whatever may be the ground of rejection." *In re Hilmer, et al.*, 149 USPQ 480, 490 (CCPA).

The claims have been limited to the preferred wood (spec. page 19, lines 8-9). No reference of record suggests these limitations, which define the preferred plank

contemplated.

The rejection of claims 1-13 under 35 USC 103(a) over Larsen in view of Webster is respectfully traversed.

Webster discloses the production of wooden panels by assembling the components in a jig with the side surfaces in side by side relationship, drilling to form bores through the components and threaded light metal dowels extended through the bores to attach the components together (col. 1 ln. 7-34). The crest of threads cut into the wood (col. 3, line 44-45) and draw the surfaces together (col. 1, ln. 54-58). The wood components are placed together prior to and during the process by "light press fit engagement," such as by a light band pressure (col. 3, lines 11-14).

Webster discloses panels made of thin elements held together by a rod. The Webster panels are placed together then drilled and the soft threaded rod inserted after the removal of the drill bit.

In addition to limitations to the preferred wood embodiment, the present claims now recite that there are at least three bore holes from a first direction and that the helical pins extend from the opposite direction. This is not taught by Webster which merely drills a guide hole for insertion of a soft screw. Similarly compression of the boards during the insertion of the present pins is now a structural limitation of the product.

Webster does not suggest that his panel is a scaffold plank. It is submitted that Webster is non analogous art to the present invention."Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference is pertinent to the particular problem

with which the inventor is involved." *In re Clay*, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992)

The purpose of both the inventor and the reference are important in determining pertinence for the different endeavor reference. If the same purpose is disclosed in the reference that supports the use of the reference, the art would likely be considered analogous. "If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it" *In re Clay, supra* at 1061. Webster is not reasonably pertinent to the particular problem with which the present applicant was involved. An inventor is not presumed to have full knowledge of prior art outside of the field of his endeavor. *In re Antle*, 170 USPQ 285, 287 (CCPA 1971); *In re Wood*, 202 USPQ 171, 174 (CCPA 1979). The issue of whether art is reasonably pertinent to the particular problem on which an inventor was involved is not soundly based on the Patent Office classification system. *In re Mlot-Fijalkowski*, 213 USPQ 713, Footnote 715 (CCPA 1982). Thus, there must be a reason or rationale (similar in logic to the requirement that there be a reason for a combination of references).

The examiner has not advanced any reason as to why Webster is pertinent other than a hindsight need for a portion of its teachings. Claims must be treated as a *whole*, not just selected bits and pieces from prior patents which might then be modified to fit an incorrect interpretation of the claims. *In re Panduit Corp. v. Dennison Manufacturing Co.* 1 USPQ2d 1593, 1605 (CAFC 1987). There is no common environment which could form a "close relationship" between either the claimed invention and either Webster or Bennett which would logically require consideration of their teachings. See *In re Pagliaro*, 210 USPQ 888, 892 (CCPA 1981). The problem which arises in viewing non analogous

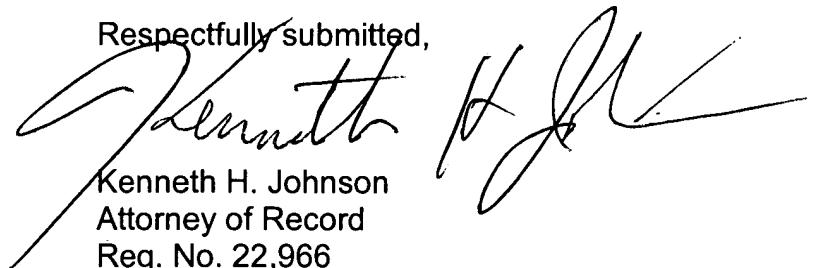
art as pertinent is that too narrow an area of the reference is focused on while the subject matter of the reference as a whole is not considered. *Pagliaro, supra* 893.

The prior art does not indicate or suggest the boards are under compression at the time of the pinning nor in particular does any of the art of record suggest the preferred boards to which the claims are now limited. Although Larsen has a pin, it serves mainly to provide an element over which to lock the U shaped clamp to lash the boards to the crossbeam and Webster by using a screw inserted into a predrilled hole would indicate that there is no compression. The present claims also incorporate as structural elements those features that result from the present process that are distinct from the prior art.

Claim 16 was rejected under 35 USC 102(b) over Anguera, however, it is submitted that the present amendment overcomes that since the reference has no mention of the limitations of the preferred boards.

It is submitted that the claims as amended are now in condition for allowance which is requested in due course.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kenneth H. Johnson", is written over the typed name and address.

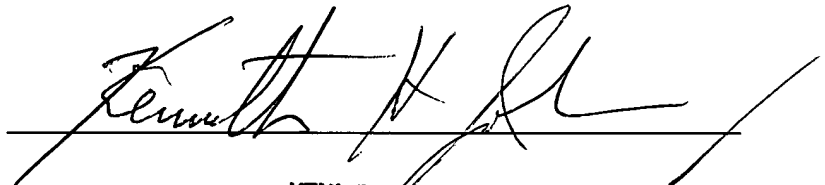
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Assistant Commissioner for Patents
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on 07/18/02.


KENNETH H. JOHNSON

1. (TWICE AMENDED) A composite scaffolding plank comprising:

a plurality of wooden boards each having a fiber bending value of at least 2200 psi, a modulus of elasticity in the range of 1.6×10^6 to 1.8×10^6 , a lengthwise direction, two opposing sides being flat and extending parallel to said lengthwise direction, each of said sides having a height, said height being the smallest dimension of said wooden boards;

said plurality of wooden boards positioned in side to side parallel abutment;

at least three bores extending through said plurality of wooden boards in a first direction;

at least three spaced helical pins extending transversely in a second direction opposite to said first direction through and imbedded in said bores in said plurality of wooden boards, said plurality of wooden boards being under compression, normal to said wooden board sides and normal to said lengthwise direction; and

said plurality of wooden boards being held together in compression by said helical pins.

7.(TWICE AMENDED) A composite scaffolding plank comprising:

a plurality of wooden boards;

each said wooden board having a fiber bending value of at least 2200 psi, a modulus of elasticity in the range of 1.6×10^6 to 1.8×10^6 and a rectangular prism shape;

each said wooden board having a length, a first end surface, a second end surface, a top surface, a bottom surface, and two opposing side surfaces;

each said side surface being narrower than said top surface, said top surface

having a width equal to a width of said bottom surface;

said plurality of wooden boards positioned with at least one of said side surfaces of each said wooden board in parallel abutment to at least one side surface of another said wooden board;

said top surfaces of said wooden boards being co-planar;

at least three bores extending through said plurality of wooden boards in a first direction;

at least three spaced helical pins extending transversely in a second direction opposite to said first direction through and imbedded in said bores in said plurality of wooden boards, normal to said opposing side surfaces; and

said plurality of wooden boards being held together in compression by said helical pins.

16.(TWICE AMENDED) A composite scaffolding plank comprising a plurality of wooden boards held together in compression by a plurality of helical pins, each of said pins having a square cross section, each said wooden board having a fiber bending value of at least 2200 psi and a modulus of elasticity in the range of 1.6×10^6 to 1.8×10^6 .